

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-13, 15-27, and 29 are pending in this application. Claims 14 and 28 were previously canceled without prejudice or disclaimer.

The outstanding Official Action includes a rejection of Claims 12 and 26 under 35 U.S.C. §103(a) as being unpatentable over Wada et al. (U.S. Patent No. 4,780,741, Wada) in view of what the outstanding Action continues to mistakenly characterize as “admitted prior art of record.”

The indication that Claims 13 and 27 are only objected to as depending from a rejected base claim and would be allowable if rewritten as indicated in the outstanding Action is gratefully acknowledged.

It is noted that page 5 of the outstanding Action states that Claims 1-11, 15-25, and 29 “are allowed.” This is consistent with the statement at page 5 of the Action mailed on October 21, 2003, that included the wrong serial No. (“10/535158” instead of -- 09/535,158--) and at page 6 of the Action mailed on December 12, 2002. However, the “Office Action Summary” sheets attached to these Actions and the one attached to the Action mailed June 6, 2003, all erroneously indicate that these “allowed” claims “are withdrawn from consideration.” That cannot be the case as there has been no restriction requirement presented in this Application and no election filed that indicates that Claims 1-11, 15-25, and 29 are non-elected.

Accordingly, the PTO is requested to correct the erroneous listing of Claims 1-11, 15-25, and 29 as being “withdrawn from consideration” that appears on the “Office Action Summary” sheet attached to the outstanding Action.

Turning to the rejection of Claims 12 and 26 under 35 U.S.C. §103(a) as being unpatentable over Wada in view of what the outstanding Action continues to mistakenly characterize as “admitted prior art of record,” it is noted that the outstanding Action has again misinterpreted the specification at page 1, lines 12-18 to be an “admission” of “prior art.” In this regard, and as previously explained, the inventors live in Japan and their statement as to what has occurred in “recent years” as to “digital type forming apparatus in which an image is formed on the basis of digital image data instead of analog image data has seen an increasing demand” is not a statement that anything is admitted to be “prior art,” as the PTO seeks to erroneously interpret it. Moreover, this statement contains no reasonable implication that because an increasing demand has occurred, the use of an image forming apparatus that is based on the noted “digital image data” is being characterized in the specification as being “conventionally known” anywhere.

Furthermore, the response to arguments at the top of page 4 of the outstanding Action attempts to create new law. In this respect, it is clearly unreasonable for the PTO to suggest that Japanese inventors working in Japan can possibly have personal knowledge as to printing devices that could be located anywhere in the world where their Japanese Application could be translated into the local language and filed under the Paris convention (note MPEP §201.13).

Finally, the only “implied” admission recognized in MPEP §2129 is the use of a Jepson claim format. Other than that, only an express statement by an applicant can be used as clearly noted here. There is no express statement by applicant present here and no Jepson Format claim. Accordingly, it is clear error for the PTO to continue to characterize the discussion at page 1, lines 12-18 as being an admission that anything is “prior art” or even “conventional” as

these words do not appear here. Also, as no Jepson claim formats are used, no implied admission can be said to be present in this application.

Turning to Wada, it is noted that the top of page 3 of the outstanding Action indicates that Wada teaches “a thin layer forming, device 7 configured to form the one-component developer being conveyed on the conveyor member into a thin uniform layer having a height corresponding to 1 to 1.5 times the diameter of the toner particles of the one-component developer.” The middle of page 4 of the outstanding Action then asserts that “[t]he height of the developer is set by the depth of the grooves and the regulating member and are thus $\frac{1}{4}$ to 3 times diameter of the developer and is clearly discussed in column 8 and shown in Figures 2 or 3.” These comments make it clear that the PTO has not properly interpreted the limitations of Claims 12 and 26 and has erred in interpreting the teachings of Wada.

In these respects, it is clear that Claims 12 and 26 both require formation of a “uniform thin layer having a height corresponding to 1 to 1.5 times a diameter of the toner particles” (emphasis added). The term “uniform” can be found in any dictionary and means that there can be no variation. However, if the grooved sleeve embodiment illustrated in Figures 2 and 3 of Wada is used, the thin layer of toner being formed cannot be said to have no height variations and, thus, cannot be said to be a “uniform thin layer” (emphasis added) as these claims require.

While a non-grooved sleeve 2 of the first embodiment of Wada can have a toner layer with a uniform height, the use of the embodiment having grooves 8 means that there must be a height variation of the toner layer between toner that fills these grooves and the toner that is over a non-grooved portion of the sleeve 2. Accordingly, the toner layer formed using the

Wada embodiment having a sleeve 2 with grooves 8 cannot be reasonably said to be a “uniform thin layer” (emphasis added).

Moreover, even if the artisan selected the Wada embodiment having a sleeve 2 with grooves 8, the depth of the grooves 8 does not alone determine the height of the Wada toner layer. The outstanding Action itself notes that the regulating member also contributes to determining the height of the Wada toner layer, not just the depth of grooves 8. Accordingly, where in Wada does the teaching appear that suggests that the spacing of regulating member 7 from sleeve 2 is to be selected in conjunction with possible groove 8 depths of from $\frac{1}{4}$ to 3 times the diameter of the Wada toner particles so as to insure that the toner layer has a height corresponding to 1 to 1.5 times a diameter of the toner particles? Also, where is the teaching in Wada as to where to measure this height in terms of the deeper groove 8 portions or shallower non-grooved portions and the reason the artisan would not select groove depths of 2 or 3 times the toner diameter?

Once again, this failure to indicate where these teaching can be found in Wada is a violation of precedent. See In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”) and 37 CFR § 1.104(c)(2) that requires that when a reference shows inventions other than the claimed one, the particular parts of that reference being relied upon “must be designated as nearly as practicable.”


Accordingly, the rejection of Claims 12 and 26 under 35 U.S.C. §103 is improper and withdrawal of this improper rejection is believed to be in order.

Appln. No. 09/535,158
Reply to Office Action of 11/12/03

As it is believe that no other issues remain outstanding in this application, it is believed that this application is in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number

22850

(703) 413-3000
Fax #: (703) 413-2220
GJM:RFC/jmp